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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,342	04/14/2004	Nobert Hofgen	HUBR-1260-US	5382

24972 7590 03/03/2006  
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NEW YORK, NY 10103-3198

EXAMINER
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MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,342	<b>Applicant(s)</b> HOFGEN ET AL.	
	<b>Examiner</b> Patricia L. Morris	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 14, 15, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-6, 13, 16 and 17 are under consideration in this application.

Claims 7-12, 14, 15, 18 and 19 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### ***Election/Restrictions***

Applicant's election with traverse of Group I and compound 1 in the reply filed on January 18, 2006 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner to search all the inventions. This is not found persuasive because for the reasons clearly set forth in the previous Office action. Moreover, applicants have failed to advance any cogent reasons as to why the inventions are not patentably distinct.

It is too burdensome for the examiner to search all of the previously noted searches in their respective, completely divergent, areas for the non-elected subject matter, as well, in the limited time provided to search one invention.

The requirement is still deemed sound and proper and is therefore maintained.

This application has been examined in regard to the elected compound wherein R<sup>1</sup>, R<sup>4</sup> and R<sup>5</sup> represent non-heterocyclic groups and R<sup>2</sup>, R<sup>3</sup> as set forth in claim 1, exclusively.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The plural 's' on "salts" makes claim 1 read on mixtures rather than specific compounds.

The expression at least one is indefinite in claim 13 since it allows other active ingredients. It is suggested that it be changed to one or more.

The claims measure the invention. *United Carbon Co. V. Binney & Smith Co.*, 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": *In re Priest*, 199 USPQ 11, at 15.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 13, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 14 of copending

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Application No. 10/825,862 in view of Hogen et al. I (US 2004/0147759), II (US 6,251,923) and Gunther et al. (US 6,432,987).

This is a provisional obviousness-type double patenting rejection.

Ser. No. 10/825,862 recites the corresponding position isomers that differ only in having a 4-, 6- or 7-hydroxy group. However, Hogen et al. I, II teach that the hydroxyl group may vary in position on the indole on closely related compounds. Gunther et al. teach the optional interchangeability of pyridine and its N-oxide. Hence, patentable distinction is not seen.

One having ordinary skill in the art would have been motivated by the disclosure of compounds disclosed in Ser. No. 10/825,862 to arrive at other compounds within the claimed genus as well as at the claimed species. The motivation to make these compounds is their close structural similarities to the disclosed compound. While homology is considered to be present even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. Attention, in this regard is directed to *In re Druey et al.*, 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

that in "We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants the term homologue is used by chemists at times in a broad sense, and at other times a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

Also, as the Court stated in *In re Payne et al.*, 606 F.2d 302, 203 USPQ 245 at 255 (CCPA 1979):

"the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound."

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In addition, any question of why would one conceive and use the similar compounds (i.e. “motivation”) is answered by the Court in *In re Gyurik et al.*, 596 F.2d 1012, 201 USPQ 552 at 557.

“In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the prima facie case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

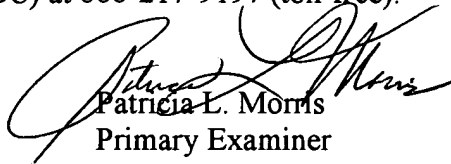
### *Conclusion*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
February 28, 2006